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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,391	09/24/2001	Hiroko Suzuki	DAIN:493A	7852

7590 12/19/2002  
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EXAMINER	
JACKSON, MONIQUE R	
ART UNIT	PAPER NUMBER

1773  
DATE MAILED: 12/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/960,391

Applicant(s)

SUZUKI ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/266,578.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The preliminary amendment filed 9/24/01 has been entered. Claims 1-21 have been canceled. New claims 22-26 have been added. Claims 22-26 are pending in the application.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ota et al (USPN 5,925,438.) Ota et al teach an anti-reflection film comprising a transparent substrate, a transparent conductive layer on the substrate, a hard coat layer formed on the transparent substrate through another layer and a low refractive-index layer formed on the hardcoat layer wherein the low-refractive index layer is a SiO<sub>2</sub> layer formed by a sol-gel process (Abstract; Example B2; Col. 11, lines 15-16.) The hardcoat layer is formed by a reaction curing resin composition. The hardcoat resin comprises a siloxane-modified acrylate and an epoxy acrylate in a 7:3 ratio (siloxane:epoxy) and no more than 50% non-reactive resin (Col. 4, lines 3-26.) The hardcoat layer has a thickness of 3-10 micrometers and is a high refractive layer comprising conductive ultrafine particles of a metal or metal oxide with a refractive index value in the range of 1.63-2.7 (Col. 4, lines 27-60.) The low refractive layer may be an organic fluorocompound layer to decrease the refractive index of the layer and may be formed from heptadecafluorodecyl trimethoxysilane, tridecafluoro-octyl trimethyloxysilane, and trifluoropropyl trimethoxysilane

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(Col. 6, 14-34.) Ota et al further teach that fine roughness or irregularities can be provided on the outermost surface of an antireflection film to impart thereto beneficial antiglaring properties wherein the roughness is produced on the surface of the underlying hardcoat layer (Figure 2; Col. 2, lines 61-64; Col. 7, lines 27-35.) Ota et al further teach that the hardcoat layer can be provided as a laminate composed of a plurality of layers in order to improve the hardness of the hard coat layer (Col. 7, lines 44-47.)

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 14 of U.S. Patent No. 6,319,594 in view of Ota et al (USPN 5,925,438.) Though the conflicting claims are not identical, they are not patentably distinct given that, in terms of the resulting product, a single layer of a hardcoat material having a particular thickness is equivalent to a plurality of adjacent hardcoat layers having a combined thickness of the single hardcoat layer and further it would have been obvious to one skilled in the art at the time of the invention to provide multiple coatings of the hardcoat layer in USPN '594 to provide a hardcoat layer with the desired thickness/hardness for a

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particular end use wherein it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, it is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960.) Additionally, Ota et al teach that the hardcoat layer of antireflection film can be provided as a laminate composed of a plurality of layers in order to improve the hardness of the hard coat layer (Col. 7, lines 44-47.) Further, with regards to Claim 23, Ota et al teach that fine roughness or irregularities on the outermost surface of an antireflection film imparts thereto beneficial antiglaring properties wherein the roughness is produced on the surface of the underlying hardcoat layer as well and hence one skilled in the art at the time of the invention would have been motivated to provide the outermost surface low refractive layer and the underlying hardcoat layer with fine roughness or irregularities to impart antiglaring properties to the antireflective film.

6. Claims 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, 12, and 14-16 of U.S. Patent No. 5,925,438. Though the conflicting claims are not identical, they are not patentably distinct because it would have been obvious to one skilled in the art at the time of the invention to combine limitations from dependent claims. Additionally, in terms of the resulting product, a single layer of a hardcoat material having a particular thickness is equivalent to a plurality of adjacent hardcoat layers having a combined thickness of the single hardcoat layer and further it would have been obvious to one skilled in the art at the time of the invention to provide multiple coatings of the hardcoat layer in USPN '438 to provide a hardcoat layer with the desired

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thickness/hardness for a particular end use wherein it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, it is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In *re Harza*, 124 USPQ 378 (CCPA 1960.)

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Niimi et al (USPN 6,146,753) teaches an antistatic hardcoat film for various displays. Taniguchi (USPN 4,765,729) teaches an anti-reflection optical article. Bright et al (USPN 5,744,227) teaches antireflective coatings on light transmissive substrates. Bright et al (USPN 5,981,059) teaches a multilayer topcoat for an optical member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson  
Patent Examiner  
Technology Center 1700  
December 16, 2002